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In re application of

Nagai et al.

Serial No. 10/030,076

Filed: January 10, 2002

For: GASKET FOR FUEL BATTERY AND METHOD OR FORMING THE SAME

DECISION ON  
PETITION

This is a decision on the PETITION UNDER 37 CFR 1.181 TO DIRECT THE EXAMINER ISSUE A NEW NON-FINAL OFFICE ACTION.

The instant application is a National Stage Application entry of PCT/JP00/03853 filed on January 10, 2002. On February 20, 2004, a non-final office action was mailed to Applicants. Applicants contacted the examiner on June 10, 2004 and pointed out that two claims were not addressed in the office action. Apparently, a preliminary amendment was lost or misplaced by the office and was never processed. On July 21, 2004, applicants again contacted the examiner. The examiner stated that no new office action would be sent out and that Applicants should respond to the outstanding office action. Applicants file a response to the outstanding office action on July 27, 2004. The instant petition was timely filed simultaneously with this response formally requesting that a new non-final office action be prepared and mailed. In response to the amendment, the examiner required a restriction requirement on August 12, 2004. In the office action, it was stated that any subsequent action would be made final because Applicants had already received a first action on the merits. In an interview on August 30, 2004, the examiner's supervisor told Applicant's representative that the restriction would rescinded in order for a decision to be made with regard to the instant petition.

The instant petition requests that a new non-final office action addressing all of the pending claims be prepared. It is also requested that applicants be given a refund of the extension of time fee paid on July 27, 2004.

### DECISION

The request for a new non-final office action to be mailed will be addressed first. Applicants have submitted a copy of the post card receipt from the office dated January 10, 2002. This receipt lists the various papers that were hand carried to the office. Among the papers listed is a preliminary amendment and an Article 19 amendment. Applicants faxed copies of the post card receipt and the amendments filed with the application to the examiner on June 10, 2004. It is clear from these documents that the original papers were either lost or misplaced by the office. It

is unclear as to why the examiner would not immediately issue a new non-final office action due to error on the part of the office.

Next, the request for a refund of the extension of time fee will be addressed. As previously stated, the examiner should have issued a new non-final office action. Applicants should not have been made to file a response to the office action mailed February 20, 2004 because said action was based on an incomplete copy of the claims. The request for a refund of the fees is appropriate.

Lastly, while not specifically addressed in the petition, the restriction requirement made by the examiner on August 12, 2004 will be reviewed. Although the examiner's supervisor rescinded the requirement in an interview on August 30, 2004, it is noted that the restriction requirement was improper on its face. The examiner required a species election and an election between numerous groups under 35 USC 121. It is noted however, that the instant application was filed under 35 USC 371. National stage applications do not fall under 35 USC 121 but rather lack of unity practice should be followed.

Accordingly, the petition is **GRANTED**. The examiner is directed to prepare a new non-final office action addressing all of the pending claims on the merits. In addition, applicants are to be refunded the extension of time fee paid on July 27, 2004.



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